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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,746	11/25/2003	Hongyu Wang	03049US	8965

7590

07/12/2005

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EXAMINER

UMEZ ERONINI, LYNETTE T

ART UNIT PAPER NUMBER

1765

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/723,746

Applicant(s)

WANG, HONGYU

Examiner

Lynette T. Umez-Eronini

Art Unit

1765

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 8-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 8-10 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/29/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-7, drawn to a polishing slurry, classified in class 252, subclass 79.1.
 - II. Claims 8-10, drawn to a method of chemical mechanical polishing, classified in class 438, subclass 692*.
2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product such as polishing a surface of a magnetic disk substrate.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Art Unit: 1765

5. During a telephone conversation with Blake T. Biederman on 6/30/2005 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-7. Affirmation of this election must be made by applicant in replying to this Office action. Claims 8-10 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 5, "at least 0.001 polynaphthalene surfactant;"

In claim 4, line 7, "at least 0.01 polynaphthalene surfactant;" and

In claim 6, line 7, "at least 0.05 to 5 sulfonated polynaphthalene surfactant" is indefinite because it is unclear what are the units (i. e. weight percent, volume, etc.,) the polynaphthalene surfactant. Also it is unclear whether a "polynaphthalene surfactant" differs or possesses some intrinsic property that is different from a generic naphthalene surfactant.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miura et al. (US 6,027,699).

Miura teaches, a polishing composition useful for polishing semiconductors (column 1, lines 1-2) and which comprises silica and water (Abstract column 3, lines 8-11). The content of silica is from 0.1 to 50 by weight (column 3, lines 56-59). Various additives such as surfactants such as sodium alkylbenzene sulfonate and a condensate of formalin with naphthalene sulfonic acid (same as applicant's polynaphthalene and sulfonated polynaphthalene surfactant) and aluminum oxides, zirconium oxides and titanium oxides, can be incorporated into the polishing composition (column 5, line 51 -

Art Unit: 1765

column 6, line 8). Miura also teaches the polishing composition has a pH of at least 7 (column 6, lines 33-35), which encompasses a pH of less than 10. The aforementioned reads on,

An aqueous polishing slurry suitable for chemical mechanical polishing semiconductor substrates, comprising, by weight percent:

0.1 to 40 weight percent metal oxide particles, the metal oxide particles having a surface and a positive surface charge;

at least polynaphthalene surfactant; and

a balance of water with the slurry, **in claim 1**;

wherein the metal oxide particles comprise an abrasive oxide selected from the group comprising alumina, aluminum hydroxide oxide, ceria, iron oxide, lanthanum oxide, magnesium oxide, nickel oxide, silica, titania, yttria and zirconia, **in claims 2, 5, and 7**;

wherein the metal oxide particles are alumina, **in claim 3**;

An aqueous polishing slurry suitable for chemical mechanical polishing semiconductor substrates, comprising, by weight percent:

0.25 to 25 and 0.5 to 15 weight percent metal oxide particles, the metal oxide particles having a surface and a positive surface charge and the metal oxide particles comprising an abrasive oxide selected from the group comprising alumina, aluminum hydroxide oxide, ceria, iron oxide, lanthanum oxide, magnesium oxide, nickel oxide, silica, titania, yttria and zirconia;

at least polynaphthalene surfactant; and

a balance of water, respectively **in claims 4 and 6**.

Muir differs in failing to specify the content of polynaphthalene surfactant as recited in claims 1, 4, and 6 and the slurry having a pH of less than 5 and 4, respectively in claims 4 and 6.

However, Miura illustrates the specific combination of a metal oxide particles, surfactant, and water is known. Since Miura teaches the same composition as claimed in the present invention, then using Miura's composition in the same manner as claimed by applicant would result the same in polynaphthalene surfactant for adsorption with at least a portion of the surface of the metal oxide particles in situ and for reducing scratching of the semiconductor substrates. Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to select any proportion surfactant and pH in the Miura reference that would effectively accomplish the disclosed composition because it has been held that there is no invention where the difference in proportions is not critical and was ascertained by routine experimentation because the determination of workable ranges is not considered inventive. See *In re Swain and Adams*, 70 USPQ 412 (CPA 1946).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynette T. Umez-Eronini whose telephone number is 571-272-1470. The examiner is normally unavailable on the First Friday.

Art Unit: 1765

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nadine Norton can be reached on 571-272-1465. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit 1765

Itue

July 1, 2005

NADINE G. NORTON
SUPERVISORY PATENT EXAMINER

